

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte JOHN M. DAVIS

Appeal No. 2006-1802
Application No. 09/785,918

ON BRIEF

Before KRASS, JERRY. SMITH, and BLANKENSHIP, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-6, 12-17, 21-28, and 30.

The invention pertains to sharing web sessions. Many times, when a user is viewing and interacting with a web site, the user may have a question concerning the web site. Rather than impersonal, pre-written instructions, which the user can obtain by pressing a "help" button, which may or may not be of help to a particular user, the invention permits a way to share a particular web session, under certain circumstances, so

that, for example, on-line help can be obtained wherein the user and the helper are viewing the same web site. When a certain event, e.g., the pressing of a “help” key, is detected at a server in a client server communication protocol, a browser session is automatically shared between at least two clients, with one of the clients being on the server side of the client server communication protocol.

Independent claim 1 is representative, and is reproduced as follows:

1. A method comprising:
detecting an event at a server in a client server communication protocol; and
upon detection of an event, sharing a browser session between at least two clients, one of said clients being on the server side of said client server communication protocol.

The examiner relies on the following references:

Picazo, Jr. et al. (Picazo)	5,432,907	Jul. 11, 1995
Quatrano et al (Quatrano)	6,748,420	Jun. 08, 2004 (filed Oct. 11, 2000)

Claims 1-6, 12-17, 21-28, and 30 stand rejected under 35 U.S.C. §103 as unpatentable over Quatrano in view of Picazo.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner

is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience – or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus, the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000). See also In re Thrift, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that

burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR §41.37(c)(1)(vii) (2004)].

In the instant case, the examiner contends that Quatrano detects an event, i.e., an HTTP request by participant 10, at a server in a client server communication protocol, referring to column 13, lines 6-15. The examiner also contends that Quatrano discloses that upon detection of an event, a browser session is shared between at least two clients, with the clients being on the client side of the client server communication protocol, referring to column 12, lines 50-65, and column 13, lines 47-58. With this much, we agree.

The examiner realizes that Quatrano does not teach one of the clients being on the server side of the client serve communication protocol, as claimed. Again, we agree. The examiner turns to Picazo for such a teaching. Specifically, the examiner notes that computers 22, 24, 26, and mainframe computers 16 and 18 are located on the same local network, and the examiner interprets the claim language, “one of said clients being on the

server side,” as one of the clients and the server being located on the same local network (answer-page 4). Therefore, the examiner concludes that there is a client on the server side of the client server communication protocol in Picazo, and that it would have been obvious to combine Quatrano and Picazo to connect one of the clients on the server side “because it would improve said client’s response time” (answer-page 4).

We REVERSE.

We agree that Quatrano describes the instant claimed subject matter but for a client being on the server side of the client server communication protocol. We also agree that Picazo describes a client being on the server side of a client server communication protocol. Where we disagree with the examiner is in the motivation that would have led the artisan to modify Quatrano in such a manner as to place a client on the server side of the client server communication protocol.

Merely because all of the elements, or steps, of a claim are shown in different prior art references does not, per se, make it obvious, within the meaning of 35 U.S.C. §103, to combine these teachings, or to modify the disclosure of one reference with a teaching of another. In the instant case, the examiner has not articulated a reason, other than a mere general assertion about improving a client’s response time, for modifying the structure of Quatrano to place one of the clients on the server side of the client server communication protocol. We find no evidence, and the examiner has pointed to nothing, which would indicate that changing the position of one client to the server side would, in

fact, improve a client's response time, as alleged by the examiner. Moreover, if response time were, indeed, improved, would this not serve as a motivation to the artisan to place *all* clients on the server side, rather than the claimed one of the two clients?

The examiner attempts to explain, at page 7 of the answer, that if a source device and a destination device are located on the same local network, without interconnection through a router, it is inherent that this would improve response time of the client and this would have led the artisan to make the combination. However, we agree with appellant, at page 2 of the reply brief, that there is no evidence that the use of routers is adverse to a good response time. We also agree that this argument about routers appears to be irrelevant to where a client is positioned relative to a server. As stated by appellant, "whether you use a router in internetwork communication or not, that still says nothing about whether you should put a client on the server side of a client-server relationship when establishing a browser session between two clients" (reply brief-page 2).

We agree with the examiner's rationale to the extent that one *could* place a client on the server side of the client server communication protocol, but we disagree with the examiner's conclusion of obviousness, within the meaning of 35 U.S.C. §103, because the examiner has offered insufficient evidence of anything that would have led the artisan to modify the system of Quatrano to provide for a client on the server side of the client server communication protocol. While such evidence may very well exist and a convincing argument might be made for so placing a client, the examiner has not provided such evidence or such argument in this case.

While we have reversed the examiner's rejection as improper, this should not be interpreted in any way as asserting that we view the instant claimed subject matter as clearly patentable. We offer an opinion only on the propriety of the rejection and the rationale offered to support it. It appears to us that the subject matter of the claims might possibly be met by any system having two clients, one on the "client" side of the network and one on the "server" side of the network and that many commercial websites interacting with customers might meet this limitation. However, we are in possession of no specific evidence that shows this and we are not at liberty to sustain a rejection or make a new ground of rejection based on what we perceive to be well known.

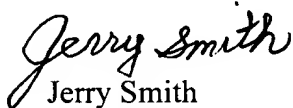
Accordingly, we will not sustain the rejection of claims 1-6, 12-17, 21-28, and 30 under 35 U.S.C. §103.

The examiner's decision is reversed.

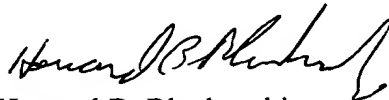
REVERSED



Errol A. Krass
Administrative Patent Judge



Jerry Smith
Administrative Patent Judge



Howard B. Blankenship
Administrative Patent Judge

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